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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,193	02/11/2004	Masakazu Aoki	500.43499X00	1623
20457	7590	12/28/2004		
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889				
			EXAMINER TRIEU, THERESA	
			ART UNIT 3748	PAPER NUMBER

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

EG

**Office Action Summary**

Application No.

10/775,193

Applicant(s)

AOKI ET AL. *ad*

Examiner

Theresa Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Feb. 11, 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Receipt and entry of Applicant's Preliminary Amendment filed on May 10, 2004 is acknowledged.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in JP on July 30, 2001. It is noted, however, that applicant has not filed a certified copy of the Japan 2001-228846 application as required by 35 U.S.C. 119(b).

### *Specification*

1. The disclosure is objected to because of the following informalities: on page 7, line 25, "of he lower casing 6" should be changed to --*of the lower casing 6* --. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claims 1, 3, 5 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Emanuelsson (Patent Number 4,070,166).***

Regarding claims 1, 3 and 5, as shown in Fig. 1, Emanuelsson discloses an oil injected screw compressor in which oil is injected into working gas to cool the working gas, the

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compressor comprising: a male/female rotors (1) arranged substantially in a horizontal direction; an inner cylindrical wall (not numbered; however, clearly seen in Fig. 1) located under said rotor casing and having a center axis substantially in a vertical direction; and an outer wall (not numbered; however, clearly seen in Fig. 1) arranged substantially in a concentric position with said inner wall, wherein a lower casing (not numbered; however, clearly seen in Fig. 1) is hermetically joined to said outer wall, so as to separate the oil from the working gas; a first passage (5, 7) for guiding the working gas compressed by said male/female rotor (1) to a second passage (6) formed between said outer wall and said inner wall is formed under a side portion of the rotor casing.

Regarding claims 6-9, Emanuelsson further discloses a discharge port (7) for guiding the working gas guided between said outer and inner walls; a case for receiving an oil separating element that separates the oil contained in compressed gas and is shaped like a filter (8); a case provided on a working gas discharge side of the rotor casing and having a discharge port (7) and leg portion provided in the lower casing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**3. *Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emanuelsson '166.***

Emanuelsson discloses the invention as recited above; however, Emanuelsson fails to disclose the outer wall being integrated with the main body casing of the compressor. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the outer wall being integrated with the main body casing of the compressor, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

**4. *Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emanuelsson '166.***

Emanuelsson discloses the invention as recited above; however, Emanuelsson fails to disclose a lower casing being joined to a flange provided on the outer wall. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the lower casing being joined to a flange provided on the outer wall, since it has been

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held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

***Prior Art***

The IDS (PTO-1449) filed on May 11, 2004 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of three patents: Tyskewicz (Patent Number U.S. 2,642,949), Riesberg et al. (Patent Number U.S. 3,386,230), Lowler et al. (Patent Number U.S. 3,191,854), each further discloses a state of the art.

***Communication***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm. The new telephone number is 571-272-4868 that will become effective after November 22, 2004.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E Denion can be reached on 571-272-4859. The new telephone number is 571-272-4859 that will become effective after November 22, 2004. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT



Theresa Trieu  
Patent Examiner  
Art Unit 3748